

DeCoster et al.

RECEIVED
CENTRAL FAX CENTER
SEP 26 2006

S/N: 10/708,657

REMARKS

In the Office Action of March 17, 2006, the Examiner imposed a Restriction Requirement of claims 22-54. The Examiner identified two alleged 'inventions' in the pending claims. The Examiner's classification of the 'inventions' included the following groups:

- Group I consisting of claims 22-50 and 54 drawn to cooling and welding systems, and classified by the Examiner in class 219, subclass 137.62.
- Group II consisting of claims 51-53 drawn to a controller and classified by the Examiner in class 219, subclass 130.1.

The Examiner further required an election of species if the invention of Group I was elected, and identified the species as follows:

- Species Ia, consisting of claims 22-39 drawn to cooling systems having respective sensing devices.
- Species Ib, consisting of claims 40-50 and 54 drawn to welding systems having temperature and/or pressure sensors.

In response, Applicant filed a timely Election and Response on May 25, 2006, in which Group I, Species Ia was elected with traverse, as deemed drawn to claims 22-39. Despite Applicant's arguments, the Examiner made the Restriction final, and withdrew claims 40-54 from consideration in the Office Action mailed June 26, 2006.

Also in the Office Action of June 26, 2006, the Examiner provisionally rejected claims 22-39 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/605,546 and also over claims 24-43 of copending Application No. 10/604,549, both of which disclose and claim welding apparatus and welding-type systems. The Examiner previously stated, in the Restriction Requirement dated March 17, 2006, that claims drawn to cooling systems and claims drawn to welding systems are "patentably distinct species." The Examiner now, however, asserts that these co-pending applications, which claim welding apparatus and welding-type systems, are grounds for a nonstatutory obviousness-type double patenting

DeCoster et al.

S/N: 10/708,657

rejection over claims 22-39 of the current application, which call for, what was previously described as, the "patentably distinct species" of a cooling system. The Examiner's reasoning for the imposed Restriction Requirement is directly opposite that of the double patenting rejection. The Examiner cannot have it both ways. If the Examiner rejects the cooling system of the current Application under the doctrine of non-statutory obviousness type double patenting over claims calling for welding-type systems and welding apparatus, then the Examiner cannot also maintain that the cooling system and welding system of the current application are patentably distinct species. Thus, Applicant believes that the Examiner's prior Restriction Requirement should be withdrawn.

In the Restriction Requirement of March 17, 2006, the Examiner stated that "Inventions I and II are related as combination and subcombination" and that "the combination as claimed does not require the particulars of the subcombination as claimed because the cooling and welding systems would function by using a power supply controller that lacks the ability to monitor temperature and pressure, without the necessity to detect connection of the welding-type component to a cooling source." *Office Action, Mar. 17, 2006, p. 2*. The Examiner also stated that "[t]he subcombination has separate utility such as use for other types of high voltage power supplies and transformers." *Office Action supra at 2*. Regarding the restriction of Species Ia and Ib, the Examiner stated that "the differences between the disclosed species are such that each species would require a different search (e.g. a search for generic cooling systems having generic sensing devices of Species Ia would not uncover welding systems having temperature and/or pressure sensors of Species Ib)" and that "[a]s a result, the species disclosed in the instant application are independent inventions as defined under MPEP 806.04." *Office Action supra at 3*.

Responsive thereto, Applicant argued that the Examiner's Restriction Requirement was improper and that, regarding the restriction of Groups I and II, the Examiner failed to show that the combination does not require the particulars of the subcombination as claimed for patentability. Also, Applicant argued that the Examiner failed to show that the subcombination has utility in another materially different combination. Regarding the restriction of Species Ia and Ib, Applicant further argued that the Examiner's statement that the species require a different field of search does not show that the species are independent inventions under MPEP 806.04, which requires the

DeCoster et al.

S/N: 10/708,657

Examiner to show that the species under a claimed genus are not connected in any of design, operation, or effect under the disclosure.

In the Office Action of June 26, 2006, the Examiner rejected Applicant's arguments as unpersuasive, stating that:

the combination and subcombination show two-way distinctness, as the combination claims (the cooling and welding systems) do not require that the controller (subcombination claims) have structural features that allow for the controller to be used specifically for welding systems (claim limitation details the controller for a "welding-type component" set forth in independent claim 51). Furthermore, the controller (subcombination) has separate utility for use in a wide variety of other high voltage power supplies and transformers, which are descriptive materially different combinations, such as for use in power plants, for example.

Id. at 2. In asserting that the cooling and welding systems of Group I do not require that the controller of Group II have structural features that allow for the controller to be used specifically for welding systems, the Examiner ignores what is called for in the claims of Group I. That is, the controller that is called for in the cooling and welding systems of Group I requires the particulars of the controller of Group II. For example, claim 30 (of Group I) calls for the controller therein to affect circulation of coolant when a welding-type component is activated. The controller of claim 31 (of Group I) is further configured, in part, to affect circulation of coolant when the welding-type component is connected to a coolant supply outlet. Also, the controller of claim 41 (of Group I) is configured, in part, to detect a connection status of a welding torch to a cooler. Claim 51 (of Group II) calls for a controller having these same elements. That is, claim 51 calls for a controller that is configured to detect connection of a welding-type component to a coolant source, and permit circulation of coolant through the welding-type component upon activation of the welding-type component. In making the restriction between Groups I and II, the Examiner appears to merely rely on preambles to restrict, and in doing so, ignores the elements called for in the claims of each group. The Examiner has failed to show how the combination of Group I does not require the particulars of the subcombination of Group II, as claimed for patentability.

Applicant also respectfully disagrees with the Examiner's assertion that the controller has separate utility in another materially different combination. The Examiner states that the controller can be used in a wide variety of other high voltage power supplies and transformers, such as for use in power plants. However, such an assertion

DeCoster et al.

S/N: 10/708,657

ignores what is called for regarding the controller. That is, the controller of claim 51 (i.e., the subcombination) is configured, in part, to detect connection of a welding-type component to a coolant source. It is clear that the controller is configured specifically for use with a welding-type device, in that it detects connection of a welding-type component to a coolant source and permits circulation of coolant through the welding-type component upon activation of the welding-type component. The Examiner has not shown that the controller of Group II, which is configured to detect connection of a welding-type device to a coolant source, has utility in a high voltage power supply or transformer system that is materially different than the systems of Group I.

For these reasons, as well as for the reasons previously set forth in the response dated May 25, 2006, Applicant respectfully believes that the restriction between Groups I and II is improper.

In the Office Action of June 26, 2006, the Examiner also stated that "the examiner respectfully disagrees with the applicants' assertion that the search for Species Ia would uncover the features of Species Ib, as Species Ib includes additional features that would not be uncovered in a search for the generic claim 22 of Species Ia." *Id. at 2*. While Applicant respectfully disagrees with the Examiner's continued assertion to this effect, the fact remains that even assuming *arguendo* that this is true, the Examiner's statement that the species require a different field of search does not show that the species are independent inventions under MPEP 806.04. As stated in Applicant's previous response to the Restriction Requirement, in order to conclude that the species are independent inventions, the Examiner must show that the "species under a claimed genus are not connected in any of design, operation, or effect under the disclosure..." *MPEP § 806.04(b)*. The Examiner has still failed to show that the species are not connected in any of design, operation, or effect under the disclosure. Instead, the Examiner again concluded that the species are independent solely based on the allegation that each species requires a different field of search. Species are not shown to be independent, however, based on a different field of search. Therefore, the Examiner has still failed to satisfy the burden required in making a species restriction requirement.

Beyond this, Applicant believes that the same field of search applies to both species. A search for a cooling system that is configured to be connectable to a welding-type component, as in claims 22 and 30 of Species Ia, would also uncover a welding

DeCoster et al.

S/N: 10/708,657

system having a cooler connected thereto, as in claims 40 and 44. Thus, a separate field of search would not be required for Species Ia and Ib.

In sum, the Examiner has not provided a valid basis for restriction between the inventions of Groups I and II, nor has the Examiner provided a valid basis for restriction between Species Ia and Ib. For at least these reasons set forth above, Applicant respectfully requests that the restriction be withdrawn. Accordingly, Applicant respectfully requests rejoinder of all claims.

Respectfully submitted,

/Kevin R. Rosin/

¹Kevin R. Rosin
Registration No. 55,584
Phone 262-376-5170 ext. 15
krr@zpspatents.com

Dated: September 26, 2006
Attorney Docket No.: ITW7510.083

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170

¹ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2623. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2623. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2623. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 50-2623.